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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,446	02/06/2002	Charles E. Romano JR.	82840LMB	9544

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 10/068,446	Applicant(s) ROMANO ET AL.	
	Examiner Betelhem Shewareged	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2002 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 and 22-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage _____ application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ✓ | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,3</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-21, drawn to recording element, classified in class 428, subclass 32.1.
 - II. Claims 22-29, drawn to method of printing, classified in class 347, subclass 105.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, (e.g., Using the recording element as wall paper or gift wrap).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

THE INVENTION OF GROUP I CONTAINS THE FOLLOWING SPECIE.

4. This application contains claims directed to the following patentably distinct species of the claimed invention: A: Recording element having an overcoat layer (claims 11-13), and B: Recording element having an inner layer (claim 14-17).

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-10 and 18-21 are generic.

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6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. During a telephone conversation with Lynne M. Blank on 09/23/2003 a provisional election was made with traverse to prosecute the invention of Group I Species A, claims 1-13 and 18-21. Applicant in replying to this Office action must make affirmation of this election. Claims 14-17 and 22-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-3, 5-8, 10, 11, 18, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Tang et al. (WO 00/53406).

Tang discloses an ink jet receiving medium having a gelatin containing ink receiving layer (page 1, line 4). The source of the gelatin can be animal skin or bones. Acid or alkaline processed gelatin, and gelatin derivatives such as phthalated, acetylated, carbamoylated, and succinated gelatin can be for this application. Different types of gelatin can be used in combination. The strength is preferably in the range of 150-350 bloom. See page 11, lines 3-9. Mordant is added to the ink receiving layer to improve water resistance of the printed image (page 11, line 14). The ink jet receiving medium further comprises an overcoat layer on the top of the ink receiving layer (claim 20). The ink receiving layer further comprises hydrophilic polymer (Table 1).

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13. Claims 1-5, 10 and 21 are rejected under 35 U.S.C. 102(b) as being anticipate by Poerschke (DE 197 21 238 A1).

Poerschke discloses an ink jet recording medium comprising an ink receiving layer containing modified gelatin (claim 1). The source of the gelatin is bone or skin (page 2, last paragraph). The gelatin is modified with alkylene succinic acid, wherein the alkylene group has 8-25, preferably 8-16 carbon atoms. Dodecenylsuccinic acid is a preferred example. See page 3, 3rd full paragraph. Since the gelatin used in the prior art is substantially identical to the gelatin used in the current application, the gelatin of the prior art inherently possesses the claimed bloom strength.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1, 10-13, 18, 19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Peternell et al. (US 6,420,016).

Peternell discloses an ink jet recording sheet comprising a support, a gelatin containing absorption layer on the support, and an ink receiving layer on the absorption layer (col. 3, line 14). The source of gelatin is pigskin or bone. Gelatin derivative such as phthalaoylated, acetylated or carbamoylated gelatin can be used (col. 4, line 1). The

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absorption layer further comprises hydrophilic polymer such as polyvinyl alcohol (col. 4, line 12). Since the gelatin used in the prior art is substantially identical to the gelatin used in the current application, the gelatin of the prior art inherently possesses the claimed bloom strength. The ink receiving layer is equivalent to the claimed overcoat layer. The ink receiving layer comprises cellulose ether such as hydroxyethyl cellulose and carboxymethyl cellulose (col. 4, line 67), and/or vinyl latex such as copolymer of vinyl monomer and (meth)acrylamide (col. 5, line 16).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tang et al. (WO 00/53406), as applied to claims 1-3, 5-8, 10, 11, 18, 20 and 21, above.

Tang fails to disclose the amount of each type of gelatin when using combination of different types of gelatin. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the content of different types of the gelatin to optimize ink drying time, water resistance and durability of the ink receiving layer. A prima facie case of obviousness may be rebutted, however, where the results of the

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optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Betelhem Shewareged
September 28, 2003.